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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,136	12/30/2003	Alfred S. Despres III	HAYES-2 CON	4064
7590	07/14/2005		EXAMINER	
Mark J. Pandiscio Pandiscio & Pandiscio 470 Totten Pond Road Waltham, MA 02154			FERGUSON, MICHAEL P	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/749,136	<b>Applicant(s)</b> DESPRES ET AL.	
	<b>Examiner</b> Michael P. Ferguson	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,9-12,17-19,21-23,26-29 and 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,9-12,17-19,21-23,26-29 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Species 1, Figure 1, claims 1, 2, 4-6, 9-12, 17-19, 21-23, 26-29 and 34, in the reply filed on June 20, 2005 is acknowledged.

### ***Claim Rejections - 35 USC § 102***

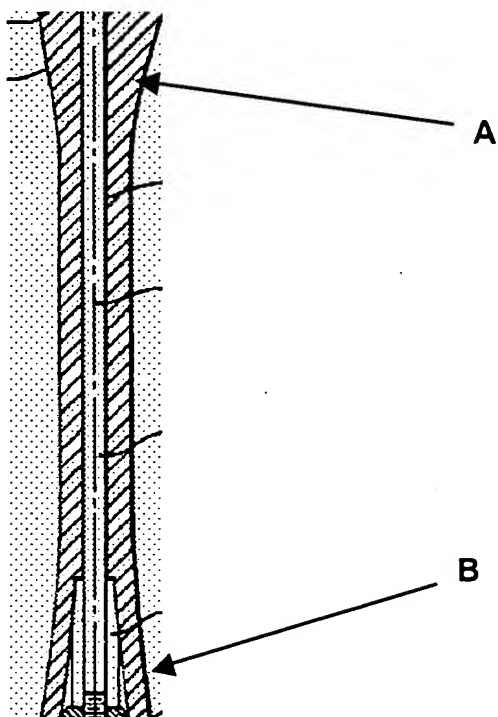
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4-6, 9-12, 17-19, 21-23, 26-29 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by DeCarlo, Jr. et al. (US 6,355,069).

As to claim 1, DeCarlo, Jr. et al. disclose a modular connection for connecting together a plurality of separate elements so as to form an orthopedic component, the modular connection comprising, in combination, a taper junction **A** (Figure 3 reprinted below with annotations) and an engaged-fit junction **B** (Figures 1-3).



As to claim 2, DeCarlo, Jr. et al. disclose a modular connection wherein the taper junction **A** is formed by the interaction of a first taper **A** with a second taper (not shown; Figure 2).

As to claim 4, DeCarlo, Jr. et al. disclose a modular connection wherein the engaged-fit junction **B** is formed by the interaction of a first concentric wall **B** with a second concentric wall (not shown; Figure 2).

As to claim 5, DeCarlo, Jr. et al. disclose a modular connection wherein the second concentric wall (not shown) is formed along a portion of a sidewall defining an aperture extending in a first, element, and the first concentric wall **B** is formed on a projection of a second element (Figure 2).

As to claim 6, DeCarlo, Jr. et al. disclose a modular connection wherein:

the taper junction **A** is formed by the interaction of a first taper **A** with a second taper (not shown), with the second taper being formed along a portion of a sidewall defining an aperture in a first element, and the first taper being formed on a projection of a second element; and

the engaged-fit junction **B** is formed by the interaction of a first concentric wall **B** with a second concentric wall (not shown), with the second concentric wall being formed along a further portion of the sidewall defining the aperture extending in the first element, and the first concentric wall is formed on a projection of the second element (Figure 2).

As to claim 9, DeCarlo, Jr. et al. disclose a modular connection wherein the first concentric wall **B** is located internally of the second concentric wall (not shown; Figure 2).

As to claim 10, DeCarlo, Jr. et al. disclose a modular connection wherein the first concentric **A** wall is deformable so as to be pressure locked against the second concentric wall (not shown; Figure 2).

As to claim 11, DeCarlo, Jr. et al. disclose a modular connection wherein the first concentric wall **A** is expandable so as to be pressure locked against the second concentric wall (not shown; Figure 2).

As to claim 12, DeCarlo, Jr. et al. disclose a modular connection wherein the second concentric wall (not shown) is formed along a portion of a sidewall defining an aperture in a first element, and the first concentric wall **B** is formed on a projection of a

Art Unit: 3679

second element, and further wherein the first concentric wall is expandable by insertion of a third element **18,20** into a recess formed in the second element (Figure 2).

As to claim 17, DeCarlo, Jr. et al. disclose a modular connection wherein the first concentric wall **B** is expandable so as to be pressure locked against the second concentric wall (not shown; Figure 2).

As to claim 18, DeCarlo, Jr. et al. disclose an orthopedic component comprising a first element and a second element, with the first element and the second element being secured to one another with a modular connection, wherein the modular connection comprises, in combination, a taper junction **A** and an engaged-fit junction **B** (Figure 2).

As to claim 19, DeCarlo, Jr. et al. disclose an orthopedic component wherein the taper junction **A** is formed by the interaction of a first taper **A** with a second taper (not shown; Figure 2).

As to claim 21, DeCarlo, Jr. et al. disclose an orthopedic component wherein the engaged-fit junction **B** is formed by the interaction of a first concentric wall **B** with a second concentric wall (not shown; Figure 2).

As to claim 22, DeCarlo, Jr. et al. disclose an orthopedic component wherein the second concentric wall (not shown) is formed along a portion of the sidewall defining an aperture extending in the first element, and the first concentric wall **B** is formed on a projection of the second element (Figure 2).

As to claim 23, DeCarlo, Jr. et al. disclose an orthopedic component wherein:

the taper junction **A** is formed by the interaction of a first taper **A** with a second taper (not shown), the second taper being formed along a portion of a sidewall defining an aperture in the first element, and the first taper being formed on a projection of the second element; and

the engaged-fit junction **B** is formed by the interaction of first concentric wall **B** with a second concentric wall (not shown), with the second concentric wall being formed along a portion of the sidewall defining the aperture in the first element, and the first concentric wall is formed on the projection of the second element (Figure 2).

As to claim 26, DeCarlo, Jr. et al. disclose an orthopedic component wherein the first concentric wall **B** is located internally of the second concentric wall (not shown; Figure 2).

As to claim 27, DeCarlo, Jr. et al. disclose an orthopedic component wherein the first concentric wall **B** is deformable so as to be pressure locked against the second concentric wall (not shown; Figure 2).

As to claim 28, DeCarlo, Jr. et al. disclose an orthopedic component wherein the first concentric wall **B** is expandable so as to be pressure locked against the second concentric wall (not shown; Figure 2).

As to claim 29, DeCarlo, Jr. et al. disclose an orthopedic component wherein the second concentric wall (not shown) is formed along a portion of a sidewall defining an aperture in the first element, and the first concentric wall **B** is formed on a projection of the second element, and further wherein the first concentric wall is expandable by insertion of a third element **18,20** into a recess formed in the second element (Figure 2).

As to claim 34, DeCarlo, Jr. et al. disclose an orthopedic component wherein the first concentric wall **B** expandable so as to be pressure locked against the second concentric wall (not shown; Figure 2).

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 2, 4-6, 9-12, 17-19, 21-23, 26-29 and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-20, 23 and 24 of U.S. Patent No. 6,669,728. Although the conflicting



Art Unit: 3679

claims are not identical, they are not patentably distinct from each other because the limitations of the application encompass the limitations of the patent. The limitations of claims 1, 2, 4-6, 9-12, 17-19, 21-23, 26-29 and 34 of the application although broader are obviously met by claims 16-20, 23 and 24 of the patent because it is obvious that the "orthopedic component comprising a first element and a second element, wherein a modular connection comprises a taper junction and an engaged-fit junction" of the instant claim 18 is encompassed by the "orthopedic component comprising a first element and a second element, wherein a modular connection comprises a taper junction and an engaged-fit junction" of patent claim 16.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure. The following patents show the state of the art with respect to orthopedic components:

Noiles et al. (US 6,264,699), Ochoa et al. (US 6,139,584), Gianezio et al. (US 4,520,511) and Kranz et al. (US 4,878,917) are cited for pertaining to components comprising a tapered junction and an engaged-fit junction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Ferguson whose telephone number is (571)272-7081. The examiner can normally be reached on M-F (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571)272-7087. The fax phone

Art Unit: 3679

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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06/29/05



DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600